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In the Supreme Court of the United States

OCTOBER TERM, 1945.

No. 292

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of HARRY O. RASTETTER, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA.

REPLY BRIEF IN SUPPORT OF PETITION

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REPLY BRIEF IN SUPPORT OF PETITION

The Brief for the Respondent in Opposition naively devotes substantially all of the Statement and Argument to a discussion of the well known rule, that commercial success is not conclusive evidence of invention; with the obvious purpose of making it appear that the Petitioners rely **entirely** and **solely** on "**commercial success**" evidence to establish the presence of invention in their improvement.

That discussion is very misleading and Respondent's Brief is silent on the Reasons Relied On in the Petition for the Allowance of the Writ, which include reference to **positive** and **undisputed evidence** of many **additional facts** showing the presence of invention, which proofs were presented to the trial court by numerous **highly skilled** and absolutely **disinterested witnesses.**

ADDITIONAL EVIDENCE OF INVENTION

The additional evidence of invention establishes numerous facts which frequently have been held sufficient to show invention; and the combination of all of the facts taken together conclusively establishes the presence of invention in Petitioner's improvement.

The **established facts** show—

1. That a **recognition** of the **beneficial results** of the improvement required **comprehensive calculation** and **special** and **extensive tests**, and did **not** result from **sales energy***;

2. That the **tests** disclosed **unexpected results** which were **revolutionary** in **character** and were **radically different** from and were an **innovation over** any **prior device**†;

3. That the **improvement satisfied** an **existing need**; because it was **lighter** and **stronger** and was **more efficient** than the previous **Standard swaged pipe boom**‡;

and

4. That the **improvement** has been so **extensively used** that it has **established** a **new industry**, and has **largely replaced** all **earlier devices**§.

Respondent's Brief beclouds the issue in stating that these proofs **only show commercial success.** The proofs were not presented for this purpose at all, but to establish Riemenschneider and Rastetter's contribution to the art in **solving a problem**, and **satisfying** a **need** by a **new structure**

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* **Fleming**, R. 26, 27; **Sundstrom**, R. 30; **Alvig**, R. 32, 33; **Vick**, 34, 35, 36; **Ebel**, R. 38, 39.

† **Fleming**, R. 26; **Vick**, R. 35; **Ebel**, R. 38.

‡ **Fleming**, R. 25, 26, 27; **Sundstrom**, R. 29, 30; **Alvig**, R. 33; **Vick**, R. 35, **Ebel**, 38, 39.

§ **Fleming**, R. 26, 27; **Sundstrom**, R. 29, 30; **Alvig**, R. 33; **Vick**, R. 35, 36; (See also R. 117, 118).

obtaining **new results, operations, functions** and **purposes, never before known or existing.**

RIEMENSCHNEIDER AND RASTETTER'S ACHIEVEMENT INVOLVES INVENTION

The **undisputed facts** of record show that **when** the **problem** was **submitted** to Riemenschneider and Rastetter they **suddenly perceived** the availability of existing elements and then conceived the idea of combining them in a **new** and **useful structure** having the **necessary functions** to **solve** the **problem** in a manner which had **never been anticipated**; all of which resulted from their **infinite capacity** for **taking pains** which was utilized in their development, so as to **qualify** them as **inventors** under the **most severe conditions** which have **ever been required** by this or any other Court.

During the recent World War II there were many **crying needs** which had to be satisfied if the prosecution of the war was to be successful. The genius of Americans and American Industry satisfied those needs and solved the problems existing. The steps taken by Riemenschneider and Rastetter in solving the problem of handling cargo by ship booms, created by the need of transporting **locomotives, tractors** and **tanks, aeroplanes** and **jeeps**, and heavy war material of every description, across the seven seas to the four corners of the earth, is but one example of the exercise of such genius.

The additional proofs presented to the trial court, which were ignored by that court in its Findings and Conclusions, establish that Riemenschneider and Rastetter **solved** a tremendously important and **unsolved problem** and **satisfied** a **crying need.**

These proofs further established their Ship Boom as an entirely **different Structure**, which obtained new and **unexpected Results** and **Functions** and operated in a **different manner** for an entirely **different purpose** than the struc-

tures, results, operations, functions and purposes of the devices disclosed in the patents which the courts below erroneously found to be anticipating.

Not one of these prior devices **solved** the **problem** or **satisfied** the **crying need.** Not one of these prior devices **suggested** a **solution** of the **problem** nor **suggested** Riemenschneider and Rastetter's **structure, results, operations, functions** and **purposes.**

SILENCE OF THE RESPONDENT

For some unaccountable reason, the Brief for the Respondent, like the decisions of the District Court and the Court of Appeals, has seen fit to ignore the foregoing facts. This silence is believed to justify a Writ of Certiorari upon **each one** of the **Questions** Presented and the Reasons Relied On, (A) because those **facts conclusively** establish—

1. The **presence** of **invention** in the sub-combination claims which have been refused;

2. The **absence** of **anticipation** in any one or all of the prior art patents;

3. The **absence** of any **findings** of **fact** and **conclusions** of **law** on **all** the **evidence adduced,** as required by Rule 52(a) of Civil Procedure;

4. The **presence** of **invention** in your Petitioners' improvement, as a **matter** of **law.**

and (B) because the Court of Appeals below—

1. Has rendered a decision in **conflict** with **other** Circuit Courts of Appeals, on the same matter;

2. Has decided **each one** of the Federal Questions Presented in a way **actually** in **conflict** with **applicable decisions** of this Honorable Court; and

3. Has so far **departed** from the **accepted** and **usual course** of **judicial proceedings** on questions of **general importance;** as to call for an exercise of this Court's power of supervision under Rule 38-5-(b), (c).

RESPONDENT'S AUTHORITIES

The Brief for the Respondent cites some twenty-one decisions of this Court and four decisions of the Courts of Appeals, presumably in support of the positions taken in the Brief. It is significant, however, that the Brief has not followed the old saying that—*"If it is worthwhile to cite a case, it is worthwhile to quote from it"*—so as to enlighten the reader of any pertinence the cases may have on the Questions Presented.

Under the circumstances, all of the cited cases have been carefully reviewed, and a digest of them has been included in an Appendix to this Brief, in an effort to save the members of this Court some of the labor of considering them.

This digest shows that many of the cases cited by the Respondent are **not pertinent** at all to the Questions Presented, and that most if not all of the remaining cases are **favorable thereto** in one or more respects.

CONCLUSION

When the ignored additional evidence and all of the facts are fully and properly evaluated, it is manifest that Petitioners are entitled to the patent which they seek; and that the Petition for a Writ of Certiorari should be granted.

Respectfully Submitted,

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Washington, D. C.
September 5th, 1946.

APPENDIX

The cases cited by the Respondent are either **not pertinent here** or clearly **justify a Writ of Certiorari.**

CASES NOT PERTINENT

Warren v. Keep (1894) 155 U. S. 265, is not pertinent nent because there was no question of **invention** involved, but only of **priority** and **infringement,** which were there decided on **conflicting** testimony of witnesses before the trial Court. That is not the situation here, where the trial Court **ignored** the **undisputed** testimony of witnesses who **established** the **presence** of **invention,** and there was **no conflicting testimony** in the present case.

Adamson v. Gilliland (1917) 242 U. S. 350, is not pertibecause there was no question of **invention** involved, but only of the **extent** of an **infringement** shown by **undisputed** testimony before the trial Court; and **"no obvious error"** or **"mistake"** was pointed out to the appellate Court. That is not the situation here, in which there was **no testimony** before the trial Court on this subject to sustain its findings and conclusions; and **that fact was pointed out to the appellate Court.**

Hydraulic Press v. Coe (1943) 134 F. 2d 49, is not pertinent because a patent was **very properly** refused under Section 4915 R. S. for **method** claims which **did not define** applicant **improvement** which **may have involved invention.**

Page v. Arkansas Gas Corp. (1932) 286 U. S. 269, 271, is not pertinent because the only issue decided was the question of **jurisdiction.**

United States v. Commercial Credit Co. (1932) 286 U. S. 63, 67, is not pertinent because it relates solely to **"unlawful transportation of intoxicating liquors"**; and the **evidence justified** the findings, which is not the situation here.

Texas & N. O. R. Co. v. Brotherhood of Railway Clerks (1930) 281 U. S. 548, 558, is not pertinent because the only issue decided was the question of **intimidation** and **coercion.**

I. T. S. Co. v. Essex Co. (1926) 272 U. S. 429, 433, is not pertinent because there was no question of **invention** and the **concurrent findings** related to a **decree pro confesso** and the **absence** of an **estoppel,** both of which were clearly established.

Abbott v. Coe (1940) 109 F. 2d 449, 451-452 is not pertinent because there were no **additional proofs** by **distinguished** and **disinterested** witnesses such as **Fleming, Sundstrom, Alvig** and **Ebel,** who testified before the trial Court; to **overcome** the **showing** in the **Patent Office record.**

Keller v. Adams-Campbell Co. (1924) 264 U. S. 314, 319, is not pertinent because a Writ of Certiorari was dismissed when there was no question of **invention,** but only the **scope** of the invention covered by the claims, and there was no **diversity** of **decision** in different Circuit Courts of Appeals.

Layne & Bowler Corp. v. Western Well Works, Inc., (1923) 261 U. S. 387, is not pertinent because a Writ of Certiorari was dismissed under circumstances similar to those in the *Keller* case.

General Talking Pictures Corp. v. Western Electric Co. (1938) 304 U. S. 175, is not pertinent because the "Questions Presented" related only to **sales restrictions** and **delayed claims** without any question of **invention.**

Keyes v. Grant (1886) 118 U. S. 25, is not pertinent because there was **conflicting evidence** in an **action** at **law** which **required** a **verdict** from the jury; and the cause was **very properly remanded** for a new trial.

McClain v. Ortmayer (1891) 141 U. S. 419, is not pertinent because one of the reasons why large sales are not always conclusive evidence, was said to be that—

> "It is impossible from this testimony to say how far the large sales of these pads is due **to their superiority to others**, or to the **energy** with which they were **forced** upon the **market.**" (Page 428.)

which reason does not apply to the present case, because here the "**superiority**" of the structure, and not any sales "**energy**", caused the extensive use of the product.

Dow Co. v. Halliburton Co. (1945) 324 U. S. 320, 330, is not pertinent because **invention** was properly denied for "3. The application of an old process to a new and analogous use"; which is not the situation here.

DECISIONS JUSTIFYING A WRIT

In *Magnaflux Corp. v. Coe* (1943) 139 F. 2d 531, the absence of invention was resolved merely upon the "**subjective opinion**" of the trial Court, was **contrary** to **undisputed** evidence, and was **improperly affirmed** by the Court of Appeals upon the **untenable theory** that—

> "**This court's function is not to register its opinion**",

as erroneously expressed in *Abbott v. Coe.* This avoidance of its **judicial functions** by the Court of Appeals, **has never been passed upon by this Court.**

In *General Motors v. Coe* (1941) 120 F. 2d 736, 737, the Court of Appeals for the District of Columbia refused to follow the **established law** in a suit under Section 4915 R. S., and judicially created a **different law** for the Courts of the District of Columbia, by following an erroneous decision, as follows—

> "But 'Whatever else may be said of the older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, **they are obviously not law in relation to appeals from the District Court.** *Minnesota Mining Co. v. Coe,* App. D. C., 118 F. 2d 593, 594.' "

It is pertinent to note that Mr. Justice *Stephen* very properly **dissented** from the Minnesota decision; and it is

believed that such **judicial legislation** cannot affect, and should justify, a Writ of Certiorari here.

In *Williams Co. v. Shoe Mach. Corp.* (1942) 316 U. S. 364, 367, the concurrent findings below were very properly sustained because—

> "These findings are to the effect that the new **combinations, while they involve old mechanical** constructions, **combine** these in a **new way** so as to **produce an improved result.**
>
> "These are findings of fact, . . . and we will not disturb such concurrent findings where, as here, **there is evidence to support them.**"

That is exactly the **reverse** of the present situation, where there is **no evidence** to support the **concurrent findings.** However, the **undisputed additional evidence** of **invention** justifies a Writ of Certiorari, here, for the **first** reason quoted above from the *Williams* case.

In *United States v. Chemical Foundation* (1926) 272 U. S. 1, 14, the same rule was properly applied under similar circumstances; but as there were **no opinion, findings,** or **conclusions** below on the evidence submitted, the present case should be reviewed by this Court.

In *Washington Securities Co. v. United States* (1914) 234 U. S. 76, 78, the findings below were properly sustained, because—

> "The rule is well settled that findings of fact concurred in by two lower courts will not be disturbed by this Court unless shown to be clearly erroneous. . . .
>
> "Applying the rule to the evidence in this case, we think the findings below should not be disturbed."

Here, there were **no findings applied to the evidence submitted** to the District Court, and for that reason alone the decision below should be reviewed by this Court.

In *Thomson Co. v. Ford Motor Co.* (1924) 265 U. S. 445, this Court refused to apply the rule of "**concurrent findings of the lower courts on questions of fact**", because there

were **conflicting decisions** on the **particular subject** in different Circuit Courts of Appeals; which should justify a similar refusal here, and the granting of a Writ of Certiorari.

In *United States v. Esnault-Pelterie* (1936) 299 U. S. 201, the proceedings in the Court of Claims was dealt with as an **action at law** with a **special verdict**, in which **"the evidence is not brought up"** (p. 205), and was properly remanded for findings of fact, which is not the situation here.

In a subsequent consideration of the same suit in 1938, 303 U. S. 26 at page 30 it was very pertinently said *per curiam* that—

> "Where, **with all the evidence before the Court**, it appears that **no substantial dispute of fact** is presented, . . . the questions of **invention** and infringement **may be determined** as **questions of law.**"

That is exactly the situation here, which should justify a Writ of Certiorari.

In *Smith v. Hall* (1937) 301 U. S. 216 at page 233 it was very pertinently said by Mr. Justice *Stone* that, **"Commercial success may turn the scale when invention is in doubt"** which is indicated by the Board of Appeals to be the situation here (R. 153), and that fact should justify a Writ of Certiorari.

In *Textile Machine Works v. Hirsch Co.* (1938) 302 U. S. 490, at page 499, it was repeated by Mr. Justice *Stone* that—**"Commercial success may be decisive where invention is in doubt"**;—which should justify a Writ of Certiorari here.

In *Special Equipment v. Coe* (1945) 324 U. S. 370 at page 377 it was said by Mr. Chief Justice *Stone* that—

> "The statutes permit, and it is the settled practice of the Patent Office, many times sustained by this Court, to allow, claims to a combination and **also its sub-combinations.**"

It is futile to argue here that "*Sub-combination claims are not ipso facto allowable,*" because it has been shown at pages 2, 3 and 4, *supra,* that "**invention**" is present in the refused claims, in **addition** to the fact that they define something "**new and useful**".

This situation satisfies **all the requirements** of R. S. 4886, 35 U. S. C. 31, and entitles the Petitioners to receive a patent by a Writ from this Court.

In *Cuno Corp. v. Automatic Device Corp.* (1941) 314 U. S. 84, at page 91 it was said by Mr. Justice *Douglas* that—

> "The new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain."

The additional evidence of invention presented in the present proceeding to the trial Court, showing that Riemenschneider and Rastetter's **new device** solved an important and difficult problem and satisfied **a crying need,** and that the device was **novel in structure,** and functioned in a novel manner to produce a **new and unexpected result** not attainable by prior devices, is believed fully to satisfy the requirements of invention as expressed in the *Cuno* case.

Respectfully Submitted,

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